

REMARKS

I. Status of the Claims

At the time of the Action, Claims 1-43 were pending. Claims 7 and 11 have been canceled above, their subject matter having been incorporated into Claim 1. All pending claims stand rejected under either Section 102(b) or Section 103(a). These rejections are addressed below.

II. Rejections Based on U.S. Patent No. 1,645,001 to Hodges (Hodges) Alone

The Action states that Claims 1, 8, 9 and 11-13 are anticipated under Section 102(b) based on Hodges, and that Claims 2, 3, 4 and 10 are obvious under Section 103(a) based on Hodges. The Action states that Hodges discloses "a golf tee comprising an elongate shaft (10) and a support cup (11). The support cup has a discontinuous annulus (note Figure 2) defining three arcuate support prongs." Based on this reading of Hodges, the Action concludes that Hodges anticipates Claim 1.

In response, Applicants direct the Examiner's attention to amended Claim 1, which recites that the upper surface of the base portion is concave and has a radius of curvature of less than 0.6 inch, such that a golf ball resting on the support prongs of the tee does not contact the base portion upper surface. This feature of Claim 1 is clearly absent from Hodges, as the "upper face of the saucer-shaped head" of Hodges is quite shallow and does not appear to be of a size that would enable it to avoid contact with a golf ball resting on the spaced sections 15. Inasmuch as at least this element of Claim 1 is absent from Hodges, Applicants respectfully submit that Hodges cannot anticipate Claim 1 or any claim depending therefrom, and requests that this rejection be withdrawn.

Moreover, Applicants respectfully submit that Hodges alone does not suggest or teach this feature. As noted in the specification, tees of the present invention may have a base upper portion that does not contact a golf ball in order to reduce the surface area of the tee that is in contact with the ball. The reduced surface area of contact can reduce the degree of friction between the ball and the tee, thereby increasing distance when the ball is struck with a golf club. In contrast, Hodges states that:

In order that the ball be more securely seated in the saucer shaped head of the tee, the edges of the head may be notched or recessed as indicated at 14 causing spaced sections in the edge of the rim to engage with the surface of the ball, these edge portions fitting into the dimples or recesses in the surface of the ball.

Hodges at page 1, lines 100-108. Thus, Hodges teaches that it is desirable that the ball be "securely seated" and that the "edge portions" of the "spaced sections" fit into the dimples or recesses in the ball. This teaching is in direct contrast to the desired result of a tee that has the prongs and concave base portion upper surface as recited in Claim 1. As such, Applicant submits that Hodges alone would not have rendered Claim 1 or claims depending therefrom obvious under Section 103(a).

III. Rejections based on Hodges in View of U.S. Patent No. 2,693,358 to Dawson (Dawson)

The Action states that Claims 15-19, 22-27, 29-33, 36-40, 42 and 43 are unpatentable under Section 103(a) based on Hodges in view of Dawson. More specifically, the Action concedes that Hodges fails to disclose or teach support prongs that have convex contact surfaces, but cites Dawson as disclosing a convex contact surface 15 in Figure 3a. Based on this disclosure, the Action concludes that it would have been obvious to the ordinarily skilled artisan to form the prongs of the Hodges tee with convex contact surfaces as suggested in Dawson.

In response, Applicants note that both the CCPA and the Federal Circuit have consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the primary reference, such a proposed modification is not proper and the *prima facie* case of obviousness cannot properly be made. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Such would clearly be the case with the rejection at hand. As noted above, the Hodges tee lacks the convex contact area recited in independent Claims 15, 29 and 43. Hodges also states that the "edge portions" between the "spaced sections" are included so that "the ball may be more securely seated in the saucer shaped head of the tee," and that the "edge portions . . . [fit] into the dimples or the recesses of the golf ball." Thus, it is clear that the purpose of the spaced

sections and edge portions of the Hodges tee are to increase, rather than decrease, interaction between the tee and ball. Conversely, the inclusion of convex surfaces on support prongs as recited in Claims 15, 29 and 43 can reduce the amount of contact area, and consequently friction and the like, between the tee and golf ball. Inasmuch as modifying the Hodges tee with convex surfaces as disclosed in Dawson would destroy the purpose of the edge portions of the Hodges tee, Applicants submit that a rejection based on Hodges in view of Dawson is improper, and respectfully request that it be withdrawn.

In addition, Applicants note that it is not entirely clear from Figure 3a of Dawson that the ball would actually rest on the bead 15; it may instead rest on the upper edges of the tube 12. as such, it is not clear that Dawson discloses this element. Of course, if this element is not present in Dawson, the rejection under Section 103(a) cannot stand.

Moreover, Applicants note that the structure of Dawson cited by the Action (the bead 15) as being a "convex surface" is not included to reduce contact area between the tee and the ball. Rather, the stated purposes of the bead 15 are that "it provides a better seat for the golf ball; it serves as a stop to limit downward movement of the element; it provides a manually engageable portion, or handle by which the tee may be held but the ball thereon." Nothing in Dawson suggests the performance advantage associated with a convex contact surface when employed as recited in Claims 15, 29 and 43.

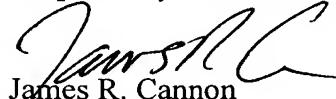
In view of the foregoing, Applicants respectfully submit that it would not have been obvious to the ordinarily skilled artisan to conceive the subject matter recited in Claims 15, 29 and 43 and claims depending therefrom. As such, Applicants respectfully request that this rejection be withdrawn.

IV. Conclusion

Inasmuch as all of the outstanding issues raised in the Action have been addressed, Applicant respectfully submits that the application is in condition for allowance, and request that it be passed to allowance and issue.

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Respectfully submitted,

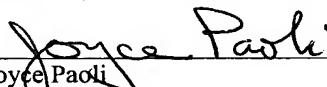


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